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BRIEF ON APPEAL

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TABLE OF CONTENTS

	<u>PAGE</u>	
I. INTRODUCTION	1	
II. REAL PARTY OF INTEREST.....	1	
III. RELATED APPEALS AND INTERFERENCES.....	2	
IV. STATUS OF THE CLAIMS	2	
V. STATUS OF THE AMENDMENTS	12	
VI. SUMMARY OF THE INVENTION	13	
VII. THE APPEALED CLAIMS	15	
VIII. THE PRIOR ART RELIED UPON	17	
IX. THE ISSUES	18	
X. THE REFERENCES	18	
XI. GROUPING OF THE CLAIMS	20	
XII. APPELLANTS' ARGUMENTS	20	
A. The rejection of Claims 1-4 and 6-16, on appeal, under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,006,227 to Freeman et al., in view of U.S. Patent No. 6,016,478 to Zhang et al., is improper.....		20
B. The rejection of Claim 5, on appeal, under 35 U.S.C. § 103(a) as being allegedly unpatentable over Freeman and Zhang and further in view of U.S. Patent No. 5,977,968 to LeBlanc is improper.....		30

	C. The rejection of Claims 17 and 18, on appeal, under 35 U.S.C. § 103(a) as being allegedly unpatentable over Freeman and LeBlanc and further in view of U.S. Patent No. 6,460,036 to Herz is improper.....	31
XIII.	CONCLUSION	33
	APPENDIX	35

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Larry Eshelman, et al. **Art Unit:** 2175

Serial No.: 09/739,475

Examiner: Hassan Mahmoudi

Filed: December 18, 2000

Docket: US000349 (16456)

For: CALENDAR SOFTWARE
APPLICATION WITH
PERSONAL AND
HISTORICAL DATA

Dated: January 30, 2004

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Sir:

I. INTRODUCTION

Pursuant to the provisions of 35 U.S.C. §§ 134 and 37 C.F.R. §§ 1.191 and 1.192, this paper is submitted as a brief setting forth the authorities and arguments upon which Appellants rely in support of the appeal from the Final Rejection of Claims 1-18 in the above-identified patent application on October 20, 2003.

II. REAL PARTY OF INTEREST

The real party of interest in the above-identified patent application is Philips Electronics North America Corporation.

III. RELATED APPEALS AND INTERFERENCES

Appellants respectfully submit that the present application is involved in no other appeal or interference besides the present Appeal.

IV. STATUS OF THE CLAIMS

The parent application, U.S. patent application Serial No. 09/739,475 was filed on December 18, 2000, and originally included Claims 1-18.

In an Official Action dated January 29, 2003, the Examiner rejected claims 1-4, 6, 7, 9-11, and 13-16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,006,227 to Freeman et al., (hereinafter "Freeman"). Additionally, the Examiner rejected claims 5, 8, 12, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of U.S. Patent No. 6,460,036 to Herz (hereinafter "Herz").

In a Response under 37 C.F.R. § 1.111, filed April 17, 2003, with regard to claim 1, Applicants argued that Freeman merely discloses organizing documents into a stream of documents that are sorted by date and that Freeman contains absolutely no disclosure or suggestion of "generating an indicator of an event responsively thereto".

With regard to claim 6, the Applicants argued that Freeman merely discloses functions (e.g., Xfer, reformatting a catalog), which upon initiation by the user, reorganizes

certain of the documents into a new stream or substream of documents and that Freeman also contains no disclosure of "automatically generating a diary record responsive to a result of said steps of accepting and prompting". Thus, Applicants concluded that Freeman contains absolutely no disclosure or suggestion of "prompting a user for greater detail in an event defined by said record" and "automatically generating a diary record responsive to a result of said steps of accepting and prompting."

With regard to claim 10, Applicants argued that Freeman merely discloses chronological indicators to indicate time, the chronological indicators do not detect "one of a passage of time since an entry of a record into a diary database and a time of day." Applicants further argued that Freeman contains no disclosure of "prompting a user to enter a diary entry responsively to said step of detecting" and that Freeman merely discloses functions (e.g., Xfer, Boolean search query), which upon initiation by the user, reorganizes certain of the documents into a new stream or substream of documents. Thus, Applicants concluded that Freeman contains absolutely no disclosure or suggestion of "prompting a user to enter a diary entry responsively to said step of detecting" and "accepting data to form a new record in a diary."

With regard to claim 14, Applicants argued that Freeman merely discloses adding a new document into the stream at the current point in time and that the Examiner picked and choose among the embodiments of Freeman and combined them as if they are disclosed as a single embodiment. Applicants further argued that Freeman contains no disclosure of "adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database" in the same embodiment as that for "extracting current events or historical data from an external data resource" or "accepting data descriptive of at least one of an appointment and an event for inclusion in a diary database". Thus, Applicants concluded that Freeman contains absolutely no disclosure or suggestion of "extracting current events or historical data from an external data resource," "accepting data descriptive of at least one of an appointment and an event for inclusion in a diary database," and "adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database."

With regard to claims 17 and 18, Applicants argued that the Examiner engaged in a rather fanciful interpretation of what is disclosed in Herz and that Herz merely describes the evaluation of the likelihood of interest in a particular target object for a user (see column 18 line 49 to column 20, line 55). In this regard, Applicants argued that the evaluation is

made by building a user profile based on the user's interests and that during the description of the evaluation, Freeman merely appreciates that a user's interests can vary according to the user's mood and therefore certain factors should be weighed more heavily than others in the evaluation. Thus, Applicants concluded that Herz contains absolutely no disclosure or suggestion of "sensing and classifying states, events, or moods of a user or said user's environment" as is recited in claims 17 and 18.

Further with regard to claims 17 and 18, Applicants argued that there is no suggestion or motivation for combining the Freeman and Herz references.

In another Official Action dated July 8, 2003, the Examiner objected to claims 1-5 because "an historical" in claim 1 should be --a historical--. In response, claim 1 was amended as suggested by the Examiner. In the Official Action, the Examiner also withdrew the previous rejections of the claims under 35 U.S.C. § 102(e) in favor of rejections under 35 U.S.C. § 103(a). Specifically, the Examiner now rejected claims 1-4 and 6-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,006,227 to Freeman et al., (hereinafter "Freeman") in view of U.S. Patent No. 6,016,478 to Zhang et al., (hereinafter "Zhang"). Additionally, the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being

unpatentable over Freeman and Zhang and further in view of U.S. Patent No. 5,977,968 to LeBlanc (hereinafter "LeBlanc"). Lastly, the Examiner rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Freeman and LeBlanc and further in view of U.S. Patent No. 6,460,036 to Herz et al. (hereinafter "Herz").

In a Response under 37 C.F.R. § 1.111, filed August 11, 2003, Applicants argued that Freeman merely discloses organizing documents into a stream of documents that are sorted by date and that Freeman does not classify one of audio, video, and text inputs into a computer. Applicants further argued that Freeman merely sorts documents (e.g., files) (which can include audio, video, or text documents) and organizes the same in a single stream of documents. Applicants further argued that Freeman also does not generate an indicator of an event responsively to the classification and that Freeman merely organizes the documents chronologically, which is not an event responsive to the classification. Furthermore, even if the "time indicator" could be considered an event, Applicants argued that it is related to the document application itself whereas claim 1 recites that the event is unrelated to the calendar/diary application. Thus, Applicants concluded that Freeman also does not disclose an event unrelated to the calendar/diary application.

Further with regard to claim 1, Applicants argued that Zhang discloses scheduling software where a user can schedule an event and send a communication to invitees of the event and that the invitees can then respond to the invitation and the system collects the responses for the user, which is totally irrelevant to the invention as recited in claim 1. The Examiner equates the event of Zhang with the event recited in claim 1. As discussed above, claim 1 recites generating an indicator of an event responsively to a classification of inputs into a computer where the event is unrelated to the calendar/dairy application. In Zhang, a user schedules an actual event (such as a meeting) and merely sends out invitations and receives responses through the scheduling software. Furthermore, in the system of Zhang, the user is not prompted to enter data relating to the event, the user him or herself indicates the event and enters data relating to the event.

Therefore, Applicants concluded that claim 1 patentably distinguishes over the combination of Freeman and Zhang and is allowable and although dependent claims 2-4 patentably distinguish over the cited references independently of claim 1, Applicants respectfully submitted that claims 2-4 are at least allowable therewith as depending from an allowable base claim.

With regard to claim 6, the Applicants argued that Freeman does not teach or suggest accepting data towards the making of a new record in a calendar application and that Freeman merely discloses reorganizing documents into a new stream or substream of documents. Applicants further argued that Zhang contains no disclosure of prompting a user for greater detail in an event defined by said record and that Zhang discloses the user selecting an Internet/Scheduling wizard icon from a menu that launches pages where the user can enter information regarding an event. Furthermore, Applicants argued that Zhang does not teach "automatically generating a diary record responsive to a result of said steps of accepting and prompting" and that Zhang discloses putting the event on the user's calendar when the user is ready to schedule the event. Thus, Applicants concluded that the update of the user's calendar is not automatic upon the prompting but upon the scheduling of the event.

Therefore, with regard to claim 6, Applicants concluded that claim 6 patentably distinguishes over the combination of Freeman and Zhang and is allowable and that although dependent claims 7-9 patentably distinguish over the cited references independently of claim 6, Applicants respectfully submitted that claims 7-9 are at least allowable therewith as depending from an allowable base claim.

With regard to claim 10, the Applicants argued that Freeman merely discloses chronological indicators to indicate time, the chronological indicators do not detect "one of a passage of time since an entry of a record into a diary database and a time of day." The chronological indicators are merely used to arrange the documents chronologically. Also as discussed above, Zhang is not concerned with entering and generating diary records. Furthermore, Zhang contains no disclosure of "prompting a user to enter a diary entry responsively to said step of detecting." As discussed above, Zhang merely allows a user to enter event information into a page in response to a user's indication of scheduling an event. Zhang does not prompt a user to enter a dairy entry responsive to a detection of a passage of time. Thus, Applicants concluded that both Freeman and Zhang contain absolutely no disclosure or suggestion of at least the detecting and prompting steps of claim 10.

Therefore, with regard to claim 10, Applicants concluded that claim 10 patentably distinguishes over the combination of Freeman and Zhang and is allowable and although dependent claims 11-13 patentably distinguish over the cited references independently of claim 10, Applicants respectfully submitted that claims 11-13 are at least allowable therewith as depending from an allowable base claim.

With regard to claim 14, Applicants argued that Zhang is not concerned with entering and generating diary records. Zhang accepts data units, which are documents to be organized, not data descriptive of an event or appointment for inclusion in a dairy database. Applicants further argued that the portion of Zhang cited by the Examiner in support of his arguments in no way teach the extracting and adding steps recited in claim 14 and are totally irrelevant thereto. The cited portion of Zhang merely discloses a parser that extracts information from an incoming message. It certainly does not disclose extracting current events or historical data from an external source. Zhang also discloses appending certain information to a message. However, such information is not current events or historical data from an external source.

Therefore, with regard to claim 14, Applicants concluded that claim 14 patentably distinguishes over the combination of Freeman and Zhang and is allowable and although dependent claims 15 and 16 patentably distinguish over the cited references independently of claim 14, Applicants respectfully submit that claims 15 and 16 are at least allowable therewith as depending from an allowable base claim.

With regard to claims 17 and 18, Applicants argued that Freeman is not concerned with accepting user input to be recorded in a dairy database and although, LeBlanc discloses a

computer system for sensing and classifying moods of user's, there is absolutely no suggestion or motivation in either Freeman or LeBlanc to use such a system in connection with a diary database. Applicants further argued that Herz merely describes the evaluation of the likelihood of interest in a particular target object for a user (see column 18 line 49 to column 20, line 55). The evaluation is made by building a user profile based on the user's interests. Thus, Applicants concluded that Herz contains absolutely no disclosure or suggestion of sensing as is recited in claim 17 and certainly does not generate an index responsive to the sensing.

Applicants also generally argued that, throughout the Official Action, the Examiner picked and choose among the embodiments of Freeman and Zhang and combined them as if they are disclosed as a single embodiment. Applicants argued that such a practice is improper.

Furthermore, although the claims of the present application patentably distinguish over the cited references, Applicants further argued that there is no motivation for combining at least the Freeman and Zhang references at least because Zhang is not directed to accepting data towards making records in a calendar application but with organizing different types of documents. Thus, those skilled in the art would not be motivated or suggested to look to the scheduling system of

Zhang for combination with Freeman, and vice versa. Therefore, Applicants concluded that the combination of at least Freeman and Zhang is improper and must be withdrawn.

Lastly, Applicants also argued that there is no motivation for combining the Freeman with the Herz or LeBlanc references because Freeman neither discloses nor suggests the use of detection of a mood as an event and neither Herz nor LeBlanc are directed to a diary/calendar. Thus, Applicants concluded that since neither Freeman, Herz, nor Leblanc expressly discuss the objectives of the present invention nor present target events to the user based upon the detection of an event, the Examiner could have only gleaned them from the present invention, which is improper as based on hindsight.

A Final Official Action was issued on October 20, 2003, in which the Examiner reiterated the rejection of claims 1-18. In response to the Final Official Action, Applicant reiterated the arguments from the previous response.

Consequently, Claims 1-18 are the claims on appeal. A copy of the rejected claims is attached hereto in the Appendix.

V. STATUS OF THE AMENDMENTS

Appellants have not filed any amendments subsequent to the issuance of the Final Rejection of October 20, 2003.

VI. SUMMARY OF THE INVENTION

The present invention relates to a method of generating a diary record, comprising the steps of: classifying at least one of audio, video, and text input to a computer and generating an indicator of an event responsively thereto; said event being unrelated to a calendar/diary application; prompting a user, by a calendar/diary application, to enter data relating to said event for incorporation in a historical record of events pertaining to a user; accepting user input responsive to said step of prompting; and adding a record to a database defining said historical record including at least one of data resulting from said step of classifying and data resulting from said step of accepting.

The present invention also relates to a method of generating a diary record, comprising the steps of: accepting data towards the making of a new record in a calendar application; prompting a user for greater detail in an event defined by said record; and automatically generating a diary record responsive to a result of said steps of accepting and prompting.

The present invention further relates to a method of generating a diary record, comprising the steps of: detecting one of a passage of time since an entry of a record into a diary database and a time of day; prompting a user to enter a

diary entry responsively to said step of detecting; accepting data to form a new record in a diary; and adding a new record responsive to a result of said step of accepting.

The present invention still further relates to a method of generating a diary record, comprising the steps of: extracting current events or historical data from an external data resource; accepting data descriptive of at least one of an appointment and an event for inclusion in a diary database; adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database.

The present invention still further relates to a method of generating a diary record, comprising the steps of: accepting user input data descriptive of personal events to be recorded in a diary database; sensing and classifying states, events, or moods of a user or said user's environment; generating an index responsive to said step of sensing; and adding said index and said user input to said diary database.

The present invention still yet further relates to a data medium having instructions thereon for implementing a method for generating a diary record, comprising the steps of: accepting user input data descriptive of personal events to be recorded in a diary database; sensing and classifying states, events, or moods of a user or said user's environment;

generating an index responsive to said step of sensing; and adding said index and said user input to said diary database.

The specification, from page 9 to page 21, discusses illustrative embodiments of the present invention in detail.

VII. THE APPEALED CLAIMS

Claims 1-18 are on appeal before the Board of Patent Appeals and Interferences, with Claims 1, 6, 10, 14, 17, and 18 being the independent claims. Independent Claim 1 is directed to a method of generating a diary record, comprising the steps of: classifying at least one of audio, video, and text input to a computer and generating an indicator of an event responsively thereto; said event being unrelated to a calendar/diary application; prompting a user, by a calendar/diary application, to enter data relating to said event for incorporation in a historical record of events pertaining to a user; accepting user input responsive to said step of prompting; and adding a record to a database defining said historical record including at least one of data resulting from said step of classifying and data resulting from said step of accepting.

Claims 2-5 directly or indirectly depend upon Claim 1 and further limit the scope of Claim 1.

Claim 6 is directed to a method of generating a diary record, comprising the steps of: accepting data towards the making of a new record in a calendar application; prompting a

user for greater detail in an event defined by said record; and automatically generating a diary record responsive to a result of said steps of accepting and prompting.

Dependent Claims 7-9 directly or indirectly depend upon Claim 11 and further limit the scope of Claim 6.

Claim 10 is directed to a method of generating a diary record, comprising the steps of: detecting one of a passage of time since an entry of a record into a diary database and a time of day; prompting a user to enter a diary entry responsively to said step of detecting; accepting data to form a new record in a diary; and adding a new record responsive to a result of said step of accepting.

Dependent Claims 11-13 directly or indirectly depend upon Claim 11 and further limit the scope of Claim 10.

Claim 14 is directed to a method of generating a diary record, comprising the steps of: extracting current events or historical data from an external data resource; accepting data descriptive of at least one of an appointment and an event for inclusion in a diary database; and adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database.

Dependent Claims 15 and 16 directly or indirectly depend upon Claim 14 and further limit the scope of Claim 14.

Claim 17 is directed to a method of generating a diary record, comprising the steps of: accepting user input data descriptive of personal events to be recorded in a diary database; sensing and classifying states, events, or moods of a user or said user's environment; generating an index responsive to said step of sensing; and adding said index and said user input to said diary database.

Claim 18 is directed to a data medium having instructions thereon for implementing a method for generating a diary record, comprising the steps of: accepting user input data descriptive of personal events to be recorded in a diary database; sensing and classifying states, events, or moods of a user or said user's environment; generating an index responsive to said step of sensing; and adding said index and said user input to said diary database.

Each of the appealed claims, mentioned supra, is set forth in the Appendix.

VIII. THE PRIOR ART RELIED UPON

The references relied upon by the Examiner in rejecting Claims 1-18 are U.S. Patent No. 6,006,227 to Freeman et al., (hereinafter "Freeman"); 6,016,478 to Zhang et al., (hereinafter "Zhang"); U.S. Patent No. 5,977,968 to LeBlanc (hereinafter "LeBlanc"); and U.S. Patent No. 6,460,036 to Herz et al. (hereinafter "Herz").

IX. THE ISSUES

The issues raised in the Final Rejection dated October 20, 2003 remaining for resolution are: whether claims 1-4 and 6-16 on appeal patentable, under 35 U.S.C. § 103(a), in light of the combination of Freeman and Zhang; whether claim 5 on appeal patentable, under 35 U.S.C. § 103(a), in light of the combination of Freeman, Zhang and LeBlanc; and whether claims 17 and 18 on appeal patentable, under 35 U.S.C. § 103(a) in light of the combination of Freeman, LeBlanc and Herz.

X. THE REFERENCES

Freeman discloses a document stream operating system that sorts documents (e.g., files) (which can include audio, video, or text documents) and organizes the same in a single stream of documents. The documents in the stream are time ordered and the stream of documents can contain a record of checks written by the user. Freeman teaches that the stream of documents being in a chronological order, adds a historical context to the collection of documents. Freeman also discloses functions (e.g., Xfer, reformatting a catalog), which upon initiation by the user, reorganizes certain of the documents into a new stream or substream of documents. Freeman also discloses chronological indicators to indicate time and adding a new document into the stream at the current point in time.

Freeman further discloses the user's stream departing to other's streams to learn of availability for a meeting.

Zhang discloses scheduling software where a user can schedule an event and send a communication to invitees of the event. The invitees can then respond to the invitation and the system collects the responses for the user. In Zhang, a user schedules an actual event (such as a meeting) and merely sends out invitations and receives responses through the scheduling software. Furthermore, in the system of Zhang, the user him or herself indicates the event and enters data relating to the event. Zhang discloses the user selecting an Internet/Scheduling wizard icon from a menu that launches pages where the user can enter information regarding an event. Zhang discloses putting the event on the user's calendar when the user is ready to schedule the event. Zhang accepts data units, which are documents to be organized and discloses a parser that extracts information from an incoming message. Zhang also discloses appending certain information to a message.

LeBlanc discloses a computer system for sensing and classifying moods of user's.

Herz describes the evaluation of the likelihood of interest in a particular target object for a user. The evaluation is made by building a user profile based on the user's interests. During the description of the evaluation,

Herz merely appreciates that a user's interests can vary according to the user's mood and therefore certain factors should be weighed more heavily than others in the evaluation.

XI. GROUPING OF THE CLAIMS

The prior art rejections of issue herein apply to more than one claim. Despite this, Appellant submits that the rejected claims stand or fall together.

XII. APPELLANT'S ARGUMENTS

A. The rejection of Claims 1-4 and 6-16, on appeal, under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,006,227 to Freeman et al., in view of U.S. Patent No. 6,016,478 to Zhang et al., is improper.

With regard to claim 1, the Examiner argues that Freeman discloses all of the features of the claim with the exception of:

"prompting a user, by a calendar/diary application, to enter data relating to said event for incorporation in a historical record of events pertaining to a user;
accepting user input responsive to said step of prompting;
adding a record to a database defining said historical record including at least one of data resulting from said step of classifying and data resulting from said step of accepting."

The Examiner cites Zhang as teaching the deficiencies in Freeman. Applicants respectfully disagree and submit that

the Examiner has engaged in a rather fanciful interpretation of both Freeman and Zhang.

As discussed previously, Freeman merely discloses organizing documents into a stream of documents that are sorted by date. Freeman does not classify one of audio, video, and text inputs into a computer. Freeman merely sorts documents (e.g., files) (which can include audio, video, or text documents) and organizes the same in a single stream of documents. Freeman also does not generate an indicator of an event responsively to the classification. Freeman merely organizes the documents chronologically, which is not an event responsive to the classification. Furthermore, even if the "time indicator" could be considered an event, it is related to the document application itself. Claim 1 recites that the event is unrelated to the calendar/diary application. As an example, claims 3 and 4 recite that the event is writing an e-mail letter and writing a letter on a text application (other than the calendar/dairy application), respectively. Thus, Freeman also does not disclose an event unrelated to the calendar/diary application.

Zhang discloses scheduling software where a user can schedule an event and send a communication to invitees of the event. The invitees can then respond to the invitation and the system collects the responses for the user. This is totally

irrelevant to the invention as recited in claim 1. The Examiner equates the event (i.e., meeting) of Zhang with the event recited in claim 1. As discussed above, claim 1 recites generating an indicator of an event responsively to a classification of inputs into a computer where the event is unrelated to the calendar/dairy application. In Zhang, a user schedules an actual event (such as a meeting) and merely sends out invitations and receives responses through the scheduling software. Furthermore, in the system of Zhang, the user is not prompted to enter data relating to the event, the user him or herself indicates the event and enters data relating to the event.

The Examiner responds to the above arguments in the Final Official Action by arguing that Freeman teaches classifying "one of audio, video, and text input" at column 2, lines 41-43. The Examiner further responds by arguing that Freeman teaches generating "an indicator of an event" at column 11, lines 57-59 (generating a reminder as an electronic mail related to an event, e.g., a meeting).

Applicants again respectfully submit that, Freeman merely organizes documents into a stream of documents that are sorted by date. Freeman does not classify the documents according to audio, video, and text inputs but is merely capable of accepting such formats and displaying the same as

"documents." Furthermore, while Freeman teaches generating an e-mail as an indicator of an event, **such an indicator is not responsive to any classification** as is recited in claim 1. The Examiner's remaining arguments with regard to claim 1 are equally without merit.

Therefore, for at least the reasons set forth above with regard to claim 1, Applicants respectfully submit that claim 1 patentably distinguishes over the combination of Freeman and Zhang and is allowable. Although dependent claims 2-4 patentably distinguish over the cited references independently of claim 1, Applicants respectfully submit that claims 2-4 are at least allowable therewith as depending from an allowable base claim.

With regard to claim 6, the Examiner argues that Freeman discloses all of the features of claim 6 with the exception of:

"prompting a user for greater detail in an event defined by said record;
automatically generating a diary record responsive to a result of said steps of accepting and prompting."

The Examiner cites Zhang as teaching the deficiencies in Freeman. Applicants again respectfully disagree.

As discussed above, Freeman does not teach or suggest accepting data towards the making of a new record in a calendar

application. Freeman merely discloses reorganizing documents into a new stream or substream of documents.

Secondly, Zhang contains no disclosure of prompting a user for greater detail in an event defined by said record. Zhang discloses the user selecting an Internet/Scheduling wizard icon from a menu that launches pages where the user can enter information regarding an event. Furthermore, Zhang does not teach "automatically generating a diary record responsive to a result of said steps of accepting and prompting". Zhang discloses putting the event on the user's calendar when the user is ready to schedule the event. Thus, the update of the user's calendar is not automatic upon the prompting but upon the scheduling of the event.

The Examiner has responded to such arguments by reiterating that Zhang teaches "automatically generating a diary record" at column 6, lines 36-38 (automatically updating the scheduling calendar). Zhang teaches, at column 6, lines 16-46, an e-mail system, which can be used to schedule a meeting. A user sends out an invitation to attend the meeting, which the invitees can accept, or decline. When the invitee accepts or declines, the system automatically updates the scheduling calendar.

Claim 6 recites (1) that a dairy record is automatically generated and (2) that such updating is

responsive to a result of the steps of accepting and prompting. Zhang teaches neither. Zhang teaches updating a scheduling calendar responsive to accepting or declining an invitation to a meeting. Zhang neither teaches updating a diary record nor updating any record responsive to accepting data towards making a new record or prompting a user for greater detail in an event defined by the record.

Therefore, for at least the reasons set forth above with regard to claim 6, Applicants respectfully submit that claim 6 patentably distinguishes over the combination of Freeman and Zhang and is allowable. Although dependent claims 7-9 patentably distinguish over the cited references independently of claim 6, Applicants respectfully submit that claims 7-9 are at least allowable therewith as depending from an allowable base claim.

With regard to claim 10, the Examiner continues to argue that Freeman discloses, "detecting one of a passage of time since an entry of a record into a diary database and a time of day." Applicants again respectfully disagree. As discussed in the previous response, Freeman merely discloses chronological indicators to indicate time, the chronological indicators do not detect "one of a passage of time since an entry of a record into a diary database and a time of day." The chronological indicators are merely used to arrange the

documents chronologically. Also as discussed above, Zhang is not concerned with entering and generating diary records. Furthermore, Zhang contains no disclosure of "prompting a user to enter a diary entry responsively to said step of detecting."

As discussed above, Zhang merely allows a user to enter event information into a page in response to a user's indication of scheduling an event. Zhang does not prompt a user to enter a dairy entry responsive to a detection of a passage of time. Thus, both Freeman and Zhang contain absolutely no disclosure or suggestion of at least the detecting and prompting steps of claim 10.

In the Final Official Action, the Examiner responds to such arguments by citing column 6, lines 3-7 of Freeman and column 13, lines 22-32 of Zhang.

With regard to Freeman, the cited portion merely teaches that the system of Freeman allows documents to be created in the future in a "future" portion of the stream of documents. Thus, a user can create a document and insert it into the stream for a future date. The system keeps the document until the future time arrives, at which point a reminder document is brought into view and the document enters the "present" potion of the stream of documents.

This is much different from that which is recited in claim 10. The system of Freeman merely allows a user to create

a document for a time in advance and is reminded when that time arrives. Claim 10 recites detecting a passage of time since an entry of a record into a diary database or a time of day and prompting a user to enter a diary entry responsive to the detecting. Freeman neither teaches the detecting nor prompts the user based on the detecting.

With regard to Zhang, the cited portion merely teaches automatically adding a meeting to an invitee's calendar when the invitee accepts an invitation to a meeting. If the meeting is declined, the system sends a message to the inviter with the invitee's reply. The reply may also include a report on the invitee's unbooked time for the next 30 days (or other interval specified by the invitee). Thus, the invitee merely specifies a time interval for his/her unbooked time. Thus, Zhang also does not teach the detecting and prompting steps recited in claim 10.

Therefore, for at least the reasons set forth above with regard to claim 10, Applicants respectfully submit that claim 10 patentably distinguishes over the combination of Freeman and Zhang and is allowable. Although dependent claims 11-13 patentably distinguish over the cited references independently of claim 10, Applicants respectfully submit that claims 11-13 are at least allowable therewith as depending from an allowable base claim.

With regard to claim 14, firstly, the Examiner again argues that Freeman discloses, accepting data descriptive of an appointment and/or an event for inclusion in a diary database.

As discussed above, Zhang is not concerned with entering and generating diary records. Zhang accepts data units, which are documents to be organized, not data descriptive of an event or appointment for inclusion in a dairy database.

Furthermore, the Examiner again argues that Zhang discloses "extracting current events or historical data from an external source" and "adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database". Applicants again disagree.

The portion of Zhang cited by the Examiner in support of his arguments in no way teach the extracting and adding steps recited in claim 14 and are totally irrelevant thereto. The cited portion of Zhang merely discloses a parser that extracts information from an incoming message. It certainly does not disclose extracting current events or historical data from an external source. Zhang also discloses appending certain information to a message. However, such information is not current events or historical data from an external source.

Furthermore, the Examiner now argues that Freeman discloses the importation of historical data from an external source at column 4, lines 26-30 ("like a diary, a stream

records evolving work, correspondence and transactions because historical context can be crucial in an organizational setting"). The cited portion of Freeman merely teaches that the stream of documents being in a chronological order, adds a historical context to the collection of documents. Freeman merely discloses the word "historical," it certainly does not disclose extracting current events or historical data from an external source nor does Freeman disclose adding such data to a diary database entry.

Therefore, for at least the reasons set forth above with regard to claim 14, Applicants respectfully submit that claim 14 patentably distinguishes over the combination of Freeman and Zhang and is allowable. Although dependent claims 15 and 16 patentably distinguish over the cited references independently of claim 14, Applicants respectfully submit that claims 15 and 16 are at least allowable therewith as depending from an allowable base claim.

In general, throughout the Official Action, the Examiner picks and chooses among the embodiments of Freeman and Zhang and combines them as if they are disclosed as a single embodiment. Applicants further submit that the Examiner equates a similar term in the references with teaching the features of the claims that use the same or similar term without considering the recitations of the claims in total.

Applicants respectfully submit that both practices are improper.

Furthermore, although the claims of the present application patentably distinguish over the cited references, Applicants further submit that there is no motivation for combining at least the Freeman and Zhang references at least because Zhang is not directed to accepting data towards making records in a calendar application but with organizing different types of documents. Thus, those skilled in the art would not be motivated or suggested to look to the scheduling system of Zhang for combination with Freeman, and vice versa. Therefore, Applicants respectfully submit that the combination of at least Freeman and Zhang is improper and must be withdrawn.

B. The rejection of Claim 5, on appeal, under 35 U.S.C. § 103(a) as being allegedly unpatentable over Freeman and Zhang and further in view of U.S. Patent No. 5,977,968 to LeBlanc is improper.

With regard to the rejection of claim 5 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and are allowable, claim 5 is at least allowable therewith as depending from an allowable base claim.

Applicants further submit that the combination of at least Freeman and Zhang is improper for the reasons discussed above with regard to claims 1, 6, 10, and 14.

C. The rejection of Claims 17 and 18, on appeal, under 35 U.S.C. § 103(a) as being allegedly unpatentable over Freeman and LeBlanc and further in view of U.S. Patent No. 6,460,036 to Herz is improper

With regard to claims 17 and 18, as discussed previously, Freeman is not concerned with accepting user input to be recorded in a dairy database. Although, LeBlanc discloses a computer system for sensing and classifying moods of user's, there is absolutely no suggestion or motivation in either Freeman or LeBlanc to use such a system in connection with a diary database. The Examiner argues that Herz generates an index responding to the step of sensing. Applicants respectfully disagree. Herz merely describes the evaluation of the likelihood of interest in a particular target object for a user (see column 18 line 49 to column 20, line 55). The evaluation is made by building a user profile based on the user's interests. Thus, Herz contains absolutely no disclosure or suggestion of sensing as is recited in claim 17 and certainly does not generate an index responsive to the sensing. Thus, as discussed above, Applicants respectfully submit that the combination of references cited by the Examiner does not teach all of the features recited in either claim 17 or 18.

The Examiner also argues that Herz adds the index and the user input to the diary database. Applicants respectfully

submit that Herz is not directed to a diary database and neither suggests one. Therefore, Applicants submit that the rejections of at least claims 17 and 18 are improper because there is no motivation or suggestion for the combination of references cited by the Examiner for at least the reasons set forth above.

Applicants respectfully submit that there is no motivation for combining Freeman with the Herz or LeBlanc references because Freeman neither discloses nor suggests the use of detection of a mood as an event and neither Herz nor LeBlanc are directed to a diary/calendar. Thus, since neither Freeman, Herz, nor Leblanc expressly discuss the objectives of the present invention nor present target events to the user based upon the detection of an event, the Examiner could have only gleaned them from the present invention, which is improper as based on hindsight.

Applicants respectfully submit that the Examiner has used impermissible hindsight to reject claims 17 and 18 under 35 U.S.C. 103(a). The Federal Circuit in In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the

Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

Furthermore, where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

XIII. CONCLUSION

In view of the remarks submitted hereinabove, the references applied against Claims 1-18 on appeal do not render those claims unpatentable under 35 U.S.C. § 103(a). Thus, Appellant submits that the § 103(a) rejections are in error and must be reversed.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection

herewith to Deposit Account No. 19-1013/SSMP. A triplicate copy of this sheet is enclosed.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Thomas Spinelli', with a stylized, looped flourish at the end.

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APPENDIX

CLAIMS ON APPEAL: CLAIMS 1-18
Application Serial No. 09/739,475

1. (Previously Presented) A method of generating a diary record, comprising the steps of:

classifying at least one of audio, video, and text input to a computer and generating an indicator of an event responsively thereto;

said event being unrelated to a calendar/diary application;

prompting a user, by a calendar/diary application, to enter data relating to said event for incorporation in a historical record of events pertaining to a user;

accepting user input responsive to said step of prompting;

adding a record to a database defining said historical record including at least one of data resulting from said step of classifying and data resulting from said step of accepting.

2. (Original) A method as in claim 1, wherein said at least one of data resulting from said step of classifying and data resulting from said step of accepting includes data resulting from said step of classifying and data resulting from said step of accepting.

3. (Original) A method as in claim 1, wherein said event includes writing an email letter.

4. (Original) A method as in claim 1, wherein said event includes writing a letter on a text application other than said calendar/diary application.

5. (Original) A method as in claim 1, wherein said event includes a change in a mood of said user.

6. (Original) A method of generating a diary record, comprising the steps of:

accepting data towards the making of a new record in a calendar application;

prompting a user for greater detail in an event defined by said record;

automatically generating a diary record responsive to a result of said steps of accepting and prompting.

7. (Original) A method as in claim 6, wherein said step of automatically generating includes:

correlating selected user input from said step of accepting with data in an external data store; and

generating a detailed description of a portion of said data accepted in said step of accepting responsively to said step of correlating whereby additional data from said

external data is used to clarify said data accepted in said step of accepting.

8. (Original) A method as in claim 7, wherein said step of automatically generating further includes requesting and accepting a confirmation by said user of said description.

9. (Original) A method as in claim 7, wherein said external data store is at least one of a contact data store, a word processing file store, an email data store, and a calendar application.

10. (Original) A method of generating a diary record, comprising the steps of:

detecting one of a passage of time since an entry of a record into a diary database and a time of day;

prompting a user to enter a diary entry responsively to said step of detecting;

accepting data to form a new record in a diary;

adding a new record responsive to a result of said step of accepting.

11. (Original) A method as in claim 9, wherein said step of accepting includes:

correlating selected user input responsive to said step of prompting with data in an external data store; and

91

automatically generating a detailed description of a portion of said data accepted in said step of accepting responsively to said step of correlating whereby additional data from said external data is used to clarify said data accepted in said step of accepting.

12. (Original) A method as in claim 11, wherein said step of automatically generating further includes requesting and accepting a confirmation by said user of said description.

13. (Original) A method as in claim 11, wherein said external data store is at least one of a contact data store, a word processing file store, an email data store, and a calendar application.

14. (Original) A method of generating a diary record, comprising the steps of:

extracting current events or historical data from an external data resource;

accepting data descriptive of at least one of an appointment and an event for inclusion in a diary database;

adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database.

15. (Original) A method as in claim 14, wherein said step of adding includes accepting user input data indicative of instructions to modify said current events or historical data.

16. (Original) A method as in claim 14, wherein said step of adding includes correlating a date corresponding to said current events or historical data with a date diary data entered in said diary database.

17. (Original) A method of generating a diary record, comprising the steps of:

accepting user input data descriptive of personal events to be recorded in a diary database;

sensing and classifying states, events, or moods of a user or said user's environment;

generating an index responsive to said step of sensing;

adding said index and said user input to said diary database.

18. (Original) A data medium having instructions thereon for implementing a method for generating a diary record, comprising the steps of:

accepting user input data descriptive of personal events to be recorded in a diary database;

sensing and classifying states, events, or moods of a
user or said user's environment;
generating an index responsive to said step of
sensing;
adding said index and said user input to said diary
database.